



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,311	05/01/2001	Ravesh Lala	RSW920010070US1	4707

7590 01/28/2005

ANDREW CALDERON
MCGUIRE WOODS LLP
1750 TYSONS BOULEVARD
SUITE 1800
MCLEAN, VA 22102

EXAMINER

VU, THONG H

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,311

Applicant(s)

LALA ET AL.

Examiner

Thong H Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2142

1. Claims 1-20 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of double patenting over claims 1-12 of U. S. Patent No. 5,675,784 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('784) 1. ...generating a screen on which a user selects a domain, a class and a subclass to input and to search data in the linked tables, said database manager allowing a user to search products meeting a particular criteria including a criteria defined by logical operators, wherein data entered in the component table includes pre-defined, standard component types with filled-in specification values such that when product components and product component specifications are added, said method allowing a user to choose from a list of common components to copy thereby promoting efficiency and data integrity, said component table further being linked to a component specification table which includes information on the predefined, standard component types with filled-in specification values and to a component group specification type usage table which contains information associating subclass component types to subclass component type specification types.

(Application) 1. A method for enabling a web server to provide a commercial promotion, comprising the acts of:

detecting a qualifying value of a commercial transaction;

checking a database of promotions for presence of a promotion that includes the qualifying value; and

when a promotion that includes the qualifying value is present in the database, executing a module of selectively executable compiled web server code that provides the promotion.

Eventhough the '784 patent did not suggest the web server code that provides the promotion of the qualifying value. It was obvious that a skilled artisan would modified the database system to provide the promoting of the predefined, standard component types with filled-in specification values in order to enhance the service via Internet.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Leal et al [Leal 6,189,003 B1] in view of Smith [6,502,076 B1].

5. As per claim 1, Leal discloses detecting a qualifying value of a commercial transaction [Leal, selection of the Internet coupons option, col 6 lines 1-63; search and extract, col 7 lines 1-10];

checking a database of promotions for presence of a promotion that includes the qualifying value [Leal, using the checkboxes on the database with attributes they wish to promote, col 7 lines col 8 line 5]; and

a promotion that includes the qualifying value is present in the database [Leal, database, col 7 lines 1-10]

However Leal does not detail a method for enabling a web server to provide a commercial promotion and executing a module of selectively executable compiled web server code that provides the promotion.

In the same endeavor, Smith discloses a system and method for determining and displaying product promotions wherein the Web server has access to a product promotion database [Smith, abstract]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of using the web server to access a promotion database as taught by Smith into the Leal's apparatus in order to utilize the database. Doing so would provide the product promotion database to Internet clients.

6. Claims 2,7,11,12,17 contain the similar limitations set forth of claim 1. Therefore, claims 2,7,11,12,17 are rejected for the similar rationale set forth in claim 1.

7. As per claims 3,13 Leal-Smith disclose the module is associated with the reward value by a pointer as inherent feature of coupons.

8. As per claims 4,14 Leal-Smith disclose the pointer is in the database [Leal, database, col 7 lines 1-10].

9. As per claim 5, Leal-Smith disclose including the act of advancing a promotion counter in response to executing the module as inherent feature of product promotion database [Smith, abstract].

10. As per claims 6,15 Leal-Smith disclose the module is associated with the reward value implicitly as inherent feature of coupons.

Art Unit: 2142

11. As per claims 8,18 Leal-Smith disclose the act of determining whether the promotion that includes the qualifying value is active further includes the act of checking a start date as inherent feature of coupons.

12. As per claims 9,19 Leal-Smith disclose the act of determining whether the promotion that includes the qualifying value is active further includes the act of checking a stop date as inherent feature of coupons.

13. As per claims 10,16,20 Leal-Smith disclose the act of advancing a promotion counter in response to executing the module as inherent feature of counter as inherent feature of product promotion database [Smith, abstract].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142

